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In re reissue application of
Megens
Application No. 08/747,873 ✓
Filed: November 13, 1996
For: U.S. Patent No. 5,042,103

In re reissue application of
Megens
Application No. 09/598,785
Filed: June 20, 2000
For: U.S. Patent No. 5,042,103

In re Megens
Reexamination Proceeding
Control No. 90/006,053
Filed: July 9, 2001
For: U.S. Patent No. 5,042,103

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REEXAM UNIT

**DECISION MERGING
REEXAMINATION
AND REISSUE
PROCEEDINGS**

The above-identified reissue applications and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,042,103 issued to Megens, on August 27, 1991.
2. A first reissue application was filed on the '103 patent on September 22, 1995, and was assigned application no. 08/532,415. The '415 reissue application is now abandoned.
3. A second reissue application, which is a continuation of reissue application no. 08/532,415, now abandoned, was filed on the '103 patent on November 13, 1996, and was assigned application no. 08/747,873. A non-final rejection was mailed on March 27, 2001, in the '873 continuation reissue application, and a response to the non-final rejection, including drawings, was received on August 27, 2001.
4. A third reissue application was filed on the '103 patent on June 20, 2000, and was assigned application no. 09/598,785. A non-final rejection was mailed on May 4, 2001, in the '785 reissue application, and a response to the non-final rejection was received on October 4, 2001.
5. A request for reexamination of the '103 patent was filed by a third party requester on July 9, 2001, and the resulting reexamination proceeding was assigned Control No. 90/006,053. On September 13, 2001, reexamination was ordered in the '6053 proceeding.
6. The time period for filing a patent owner's statement under 37 C.F.R. § 1.530 has expired, and no owner's statement has been received in the '6053 proceeding.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue applications and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6053 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '6053 reexamination file shows that the original specification, drawings and patent claims 1-11, are presently in the reexamination file. The reexamination proceeding is awaiting the examiner's preparation of a first Office action on the merits.

A review of the second reissue (Application No. 08/747,873) prosecution history shows that the continuation reissue application was affirmed-in-part at the Board of Patent Appeals and Interferences (BPAI), and a nonfinal Office action was mailed on March 27, 2001. A response to the nonfinal Office action was received on August 27, 2001, and the application is awaiting a second Office action on the merits by the examiner. In the reissue application, applicant includes original patent claims 4 and 6-11, and has amended claims 1-3 and 5 and submitted new claims 12-16 and 22-27 for consideration (claims 17-21 have been canceled), as well as amended the specification at Cols. 1 and 2, and amended Figures 3 and 5. It should be noted that the amendments of June 25, 2001, and August 27, 2001, have not been entered, as they are not in compliance with the format for amending reissue applications, specifically 37 C.F.R. § 1.173.

A review of the third reissue (Application No. 09/598,785) prosecution history shows that a nonfinal Office action was mailed on May 4, 2001. A response to the nonfinal Office action was received on October 4, 2001, which response includes amendments that are not in the proper amendment format for reissue

applications (37 C.F.R. § 1.173). The application is awaiting a second Office action on the merits by the examiner. In this reissue application, applicant has canceled claims 1-24 and submitted new claims 25-47 for consideration, as per the amendment of June 20, 2000. It should be noted that since the amendment to the specification filed on October 4, 2001, is not in compliance with the format for amending reissue applications, specifically 37 C.F.R. § 1.173, it has not been entered.

Thus, the claims are not identical in all three proceedings. In order to provide efficient, consistent and prompt handling of all three proceedings, it is appropriate that the reissue applications and the reexamination proceeding be merged and a joint examination be conducted. Accordingly, the examination of the reissue applications and the reexamination proceeding will be conducted in accordance with the decision set forth below.

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-identified reissue applications and reexamination proceeding are *sua sponte* merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in All Proceedings

The above-identified reissue applications and reexamination proceeding are merged in accordance with 37 C.F.R. § 1.565(d), for the **purpose of joint examination only**. In view of the fact that the two reissue applications contain separate sets of claims, which is appropriate under 37 C.F.R. § 1.177(b), the requirement for patent owner to present the same claims in all three cases is hereby **waived**.

However, since the amendments of June 25, 2001, and August 27, 2001, in reissue application no. 08/747,873 have not been

entered, and since the amendment to the specification filed on October 4, 2001, in reissue application no. 09/598,785 has not been entered, patent owner/applicant is hereby given **one month** from the mailing date of this merge decision in which to file proper reissue amendments in compliance with 37 C.F.R. § 1.173. Such amendments should be filed in accordance with the procedure set forth in Part III. of this decision, the third paragraph, items 2-4 below. Note that it is not necessary to file a copy of any of the amendments from the reissue applications in the reexamination proceeding at this time, as discussed in more detail below.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

The requirement that the same Office actions and patent owner responses will be placed in all three cases is hereby **waived**.

Each proceeding will proceed **independently, but simultaneously**, within the merged proceedings, as follows:

1. A joint examination of the proceedings will be conducted, and any Office actions will be **mailed at the same time** in both reissue cases.
2. The patent owner is **required to file responses** in both reissue cases independently, but **simultaneously**.
3. Such responses should include identifying data, e.g., the application number, for that case, but should also make reference to the other two cases of the merged proceeding.
4. Any such responses must be served on the third party requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(f).

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5. Due to the different claims in all three cases, and because the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, the reexamination file will remain dormant, in that no papers mailed by the USPTO nor any papers filed by patent owner, pertaining to the merged proceeding, will be made of record in the reexamination file at this time, although all of the papers mailed/filed in the two reissue applications will constitute the merged proceeding.

6. Due to the unique nature of these merged proceedings, all papers will be centrally processed in the USPTO by the Central Reexamination Unit (CRU), and will be scanned into the electronic database (REPS) in the CRU, so as to be readily available for public viewing and copying. The reissue application files will be electronically linked to the reexamination proceeding file, as they constitute the merged proceeding.

When all claims are indicated to be allowable in one of the cases, all three files must be returned to the Office of Patent Legal Administration for reconsideration of the merge decision. At that time, the Office of Patent Legal Administration may consider suspending the allowable case, to await conclusion of the other proceedings, in order to permit the cases to issue simultaneously.

If the reissue applications ultimately mature into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action in one of the reissue applications, the merged proceeding will be terminated as follows. That reissue application will be held abandoned, and the merger will be dissolved as to that reissue application. However, the other two cases will remain intact, and must be returned to the Office of Patent Legal Administration for reconsideration of the merge decision, which will most likely result in reverting to normal reissue/reexamination merger practice.

If the applicant/patent owner fails to file a timely and

appropriate response to any Office action in both of the reissue applications, the merged proceeding will be terminated as follows. The reissue applications will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under 37 C.F.R. § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

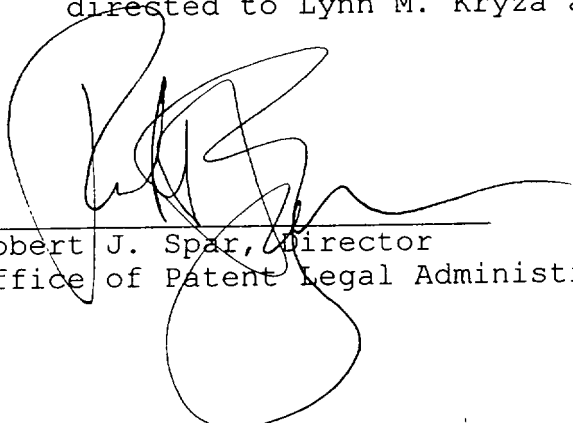
If the applicant/patent owner files an express abandonment in one of the reissue applications pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, and the merged proceeding will be dissolved as to that reissue application. However, the other two cases will remain intact, and must be returned to the Office of Patent Legal Administration for reconsideration of the merge decision.

If the applicant/patent owner files an express abandonment in both of the reissue applications pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonments, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The above-identified reissue applications and reexamination proceeding **ARE MERGED** into a single consolidated proceeding. A copy of this merge decision will be made of record in each of the three files.
2. The requirement for placing the same amendments in all three cases of the present merged proceeding is waived.

3. Patent owner/applicant is given **one month** from the mailing date of this merge decision in which to file proper reissue amendments in compliance with 37 C.F.R. § 1.173, since the amendments of June 25, 2001, and August 27, 2001, in reissue application no. 08/747,873 and the amendment filed on October 4, 2001, in reissue application no. 09/598,785 have not been entered. Such amendments must be filed in accordance with the procedure set forth in Part III. of this decision, the third paragraph, items 2-4, above.
4. The cases will be stored in the CRU to await the receipt of such proper reissue amendments, or expiration of the one month time period for filing such amendments, whichever comes first.
5. The reissue application files and the reexamination file will then be forwarded to the Group Director of Technology Center 3600. All further examination should be conducted in accordance with this decision. The examiner should prepare Office actions on the merits for the present merged proceeding of the reissue applications and reexamination proceeding, which Office actions and all files should be forwarded to the CRU for central processing and simultaneous mailing of the Office actions.
6. If all claims are indicated to be allowable in one of the three cases, all three files **must be returned** to the Office of Patent Legal Administration for reconsideration of the merge decision, and consideration of possible suspension of such case.
7. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.


Robert J. Spar, Director
Office of Patent Legal Administration

April 26, 2002